

Remarks

Claims 1, 3-12, and 15-26 are currently pending and stand rejected under 35 USC §103(a). No claims have been amended. No new claims have been added. No new matter has been included. Applicants assert that all claims are now in condition for allowance as set forth more fully below.

103 Rejections

Claims 1, 3, 7 and 16-17 stand rejected under 35 USC 103(a) as being unpatentable over Greenstein (US Pat 6,266,692) in view of Shiavone (US Pat App. 2002/0120702). Claims 4-6, 8-12, 15 and 18-26 also stand rejected under 35 USC §103(a) as being unpatentable over Greenstein in view of Shiavone and further in view if Paul (US Pat. 5,999,932). Applicants respectfully traverse these rejections.

Claims 1, 3-6, 7 and 16-17

Independent claims 1 and 16 stand rejected under 35 USC 103(a) as being unpatentable over Greenstein in view of Schiavone. However, independent claims 1 and 16 include recitations neither disclosed nor suggested by either Greenstein or Schiavone individually or in combination.

Greenstein has been relied on by the Office Action for the proposition that it teaches the elements of the rejected claims. Specifically Greenstein is cited for providing a method for blocking unwanted e-mail using a recipient-provided pass code to identify the sender and if the requisite pass code is present to then present the e-mail to the recipient. However, the Office Action concedes on page 4 that Greenstein does not teach identifying whether the e-mail has a vendor registration *purpose code* for identifying the purpose of the e-mail and then presenting the e-mail with other e-mail having the same vendor registration code and vendor registration code.

The Office Action proceeds to rely on Shiavone for disclosing a system and method for “categorization and categorized display of messages in a recipient’s mailbox which is divided into sections acting like multiple mailboxes, each section displaying messages falling in certain corresponding category”. In Shiavone, the incoming e-mail is associated with a category of the recipient’s inbox by reading an identifier from the

header information of the incoming e-mail which is then compared to a list of category identifiers of the recipient's inbox. If the message identifier does not match a recipient's category identifier the message is shunted to a "Bulk" file. (Para 0058). The category identifier is provided by software used by the *sender* or another party such as an *internet service provider*. (Para. 0051). However, Schiavone fails to teach the use of a vendor registration purpose code that was previously *assigned by the recipient*.

As a representative sample amended claim 1 recites,

"a method of sorting e-mail, comprising...if the e-mail has a vendor registration code that was previously assigned to the e-mail source and the e-mail has a vendor registration purpose code that was previously assigned by the recipient to the e-mail source, presenting the e-mail with other e-mails having vendor registration codes; and if the e-mail does not have a vendor registration code that was previously assigned to the e-mail source or the e-mail does not have a vendor registration purpose code that was previously assigned by the recipient to the e-mail source, sending a message to the e-mail source."

Assigning a vendor registration purpose code by the sender or a third party like an ISP is not assigning a vendor registration purpose code to the source by the recipient. As such, neither Greenstein nor Schiavone or their combination teaches all of the elements recited in amended independent claims 1 and 16. Furthermore, upon a close reading, neither Greenstein nor Schiavone offers a teaching, suggestion or motivation to combine the references particularly since Schiavone does not disclose the recipient assigning any codes at all. A reference must provide an explicit or implicit suggestion, teaching or motivation in order to be §103 prior art. (See, *In Re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2D (BNA) 1614 (Fed. Cir. 1999) (Placing a pumpkin face on an orange trash bag not obvious under 35USC§103 without finding of suggestion, teaching or motivation in the reference). Further still, an argument based on the theory that "it was obvious to try" fails as an obviousness rejection. *In re Fine*, 837 F.2d 1071, U.S.P.Q.2D 1596 (Fed. Cir 1988).

Therefore, since neither Greenstein nor Schiavone teaches or suggests all of the elements of amended claims 1 and 16, amended claims 1 and 16 are allowable over Greenstein in view of Schiavone for at least these reasons. Dependent claims 3-6, 7 and 17 depend from allowable claims 1 and 16 and are allowable for at least the same reason.

Claims 8-12, 15 and 18-26

Claims 8-12, 15 and 18-26 stand rejected under 35 USC 103(a) as being unpatentable over Greenstein in view of Schiavone and further in view of Paul. Applicants respectfully traverse these rejections.

The Office Action rejects independent claims 8, 18 and 21 by asserting that independent claims 8, 18, and 21 are unpatentable for the same reason as claims 1 and 16, above. However, amended independent claims 8, 18 and 21 each recites similar subject matter recited in amended claims 1 and 16 that is not taught or suggested in Greenstein in view of Schiavone. As a representative sample amended independent claim 8 recites,

“a method of sorting e-mails, comprising...if the e-mail has a vendor registration code that was previously assigned to the e-mail source and the e-mail has a vendor registration purpose code that was previously assigned by the recipient to the e-mail source, presenting the e-mail with other e-mails received from sources registered to forward e-mails; and

if the e-mail does not have a vendor registration code that was previously assigned to , the e-mail source or the e-mail does not have a vendor registration purpose code that was previously assigned by the recipient to the e-mail source, sending a message to the e-mail source.”.

For at least the same reasons discussed above in regards to the allowability of independent claims 1 and 16, neither Greenstein nor Schiavone nor their combination teach a vendor registration purpose code assigned to the vendor by the recipient.

Similarly, a careful reading of Paul shows that Paul fails to teach or suggest the deficiencies of Greenstein and Schiavone. Paul teaches collecting acceptable e-mail source addresses and creating an inclusion list to then screen additional incoming e-mail. (Col. 4, l. 41-50). Creating an inclusion list by collecting acceptable e-mail address information is not assigning a vendor registration purpose code. As such, Paul also fails to teach or suggest the deficiencies of Greenstein and Schiavone. Since the combination of Greenstein, Schiavone and Paul fail to teach or suggest all of the elements of amended independent claims 8, 18 and 21, amended independent claims 8, 18 and 21 are allowable over the combination of Greenstein, Schiavone and Paul. Dependent claims 9-12, 15, 19-20 and 22-26 depend from independent claims 8, 18 and 21 are allowable for at least the same reason.

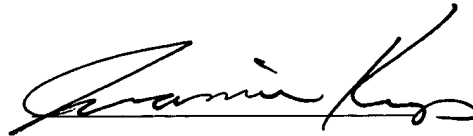
Conclusion

Claims 1, 3-12 and 15-26 are pending. Claims 1, 8, 16, 18 and 21 have been amended. No new subject has been added. Applicant requests reconsideration of claims 1, 3-12 and 15-26 in view of the amendment and remarks above and further request that a Notice of Allowability be provided. Should the Examiner have any questions, please contact the undersigned.

No fees are believed due. However, please charge any additional fees or credit any overpayment to Deposit Account No. 50-3025.

Respectfully submitted,

Date: November 30, 2005

A handwritten signature in black ink, appearing to read "Jeramie J. Keys", written over a horizontal line.

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